

REMARKS

The Examiner's communication dated January 26, 2005 has been received and carefully considered. In conformance with the applicable statutory requirements, this paper constitutes a complete reply and/or a bona fide attempt to advance the application to allowance. Specifically, claim 21 has been amended. Reexamination and/or reconsideration of the application as amended are respectfully requested.

Summary of the Office Action

Claims 1-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over "Admitted Prior Art hereinafter' APA (fig. 1 of the application) in view of Yamada et al." (U.S. Patent No. 4,827,897).

The Claims Distinguish Patentability Over the Reference(s) of Record

Claim 1 calls for a wire feeder comprising a set of feed rolls driven by a DC motor with a commutator, and having a first brush at a given position on the commutator and connected to a first lead, a second brush circumferentially spaced from the first brush a first annular distance around the commutator and connectable to a second lead to cause the motor to rotate at a first speed to drive the rolls at a first speed, and a third brush circumferentially spaced from the first brush a second annular distance around the commutator and connectable to the second lead to cause the motor to rotate at a second speed to drive the rolls at a second speed. Further, claim 1 calls for a switching circuit with an operative condition to connect the second lead to a selected one of the second and third brushes.

The Examiner asserts that FIGURE 1 of the application, which was identified as prior art, discloses all aspects of claim 1 except for "a third brush circumferentially spaced from said first brush a second annular distance around said commutator and connectable to said second lead to cause said motor to rotate at a second speed to drive said rolls at a second speed, and a switching circuit with an operative condition to connect said second lead to a selected one of said second and third brushes." (Office Action at pages 2-3). However, the Examiner further asserts that it would have been obvious to one of ordinary skill to provide an additional brush, i.e., a third brush, to FIGURE 1 "in order accommodate arrangement of Yamada et al. as describes above that would provide the motor easily change the rotation of the speed [sic]." (Office Action at page 3). Applicant respectfully disagrees.

First, Applicant respectfully asserts that FIGURE 1 of the instant application and Yamada et al. are directed toward nonanalogous art. While FIGURE 1 relates to a wire feeder for an electric arc welder having a set of feed rolls driven by a DC motor, Yamada et al. relates to a fuel pump driving apparatus which is used with an engine including a fuel injection system (Col. 1, lines 5-7). Applicant asserts that the fields of endeavor of FIGURE 1 and Yamada et al. are entirely distinct and not likely to be cross-referenced by applicants or those skilled in the art practicing in one or the other of the two fields of endeavor. Moreover, Applicant asserts that one skilled in the art would not look toward a fuel pump driving apparatus to improve the drive system of a wire feeder for an electric arc welder.

Second, Applicant asserts that one skilled in the art would not be motivated to combine FIGURE 1 with Yamada et al. The Examiner has provided no reference, or other evidence to support his conclusion that it would be obvious to one skilled in the art to modify the teachings of FIGURE 1 with the teachings of Yamada et al. Applicant asserts that the Examiner has impermissibly concluded that claim 1 is obvious in view of a combination of FIGURE 1 and Yamada et al. without any legitimate support on the record and respectfully requests that, in accordance with the obligations imposed under MPEP § 2144.03, the Examiner provide a reference or other suitable evidence showing that one skilled in the art would be motivated to modify the teachings of FIGURE 1 with the teachings of Yamada et al.

As the Examiner is certainly aware, a *prima facie* case of obviousness is not established absent proper motivation. Simply because the wire feeder shown in FIGURE 1 could be modified to include the fuel pump driving apparatus of Yamada et al., motivation to modify and/or combine the teachings of FIGURE 1 and Yamada et al. is not found. Further, according to MPEP § 2144.01, the "fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness." Merely because the claimed elements are individually found in the prior art, it does not necessarily follow that it would be obvious to combine the elements from different prior art references. See MPEP § 2141.01 *citing Ex parte Levengood*, 28 USPQ 2d 1300 (Bd. Pat. App. & Inter. 1993). Consequently, absent a motivation to combine and modify, it is irrelevant that the elements and/or limitations may be individually or separately known in the prior art. Clearly, the Examiner is motivated to combine FIGURE 1 and the teachings of Yamada et al. for no

other reason than to arrive at the claimed invention of claim 1. This is a classic example of impermissible hindsight.

Accordingly, for at least these reasons, Applicant asserts that claim 1 and claims 2-17 dependent therefrom are in condition for allowance.

Claims 2-22 were summarily dealt with in the Office Action in a single sentence wherein the Examiner stated "[r]egarding claims 2-22, the proposal in combination of the APA and Yamada et al. disclose all the aspect of the claimed invention [sic]." (Office Action at page 3). This complete lack of detail concerning claims 2-22 has not presented the Applicant with an opportunity to fairly respond to the rejections being proffered by the Examiner. The Examiner's cursory treatment of these claims does not comply with MPEP § 706 which clearly states that the goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. Without specific application of the prior art to the claim limitations included in each of claims 2-22, Applicant is unfairly burdened with trying to determine why and how the Examiner is applying the prior art to these claims.

According to the MPEP, the initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. MPEP § 706.02(j). Moreover, to establish a *prima facie* case of obviousness, the Examiner must show three basic criteria: motivation to combine the references, a reasonable expectation of success and a teaching or suggestion of each of the claim limitations. *Id.* The Examiner has not made such a showing for any of claims 2-22. The MPEP goes on to state that it is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. *Id.* This has not been done in the Office Action to which this paper is responsive.

Accordingly, Applicant requests that the § 103 rejection concerning at least claims 2-22 be withdrawn. Alternatively, if the Examiner maintains the rejections of claims 2-22, Applicant request that the Examiner provide specific arguments supporting his position as to why each of claims 2-22 stands rejected. Moreover, Applicant asserts that any continued rejection of claims 2-22 should not be made final because Applicant has yet to be given an opportunity to fairly respond to the Examiner's rejection of these claims as no detailed and/or clearly articulated reasons have been provided with the rejections.

CONCLUSION

All formal and informal matters having been addressed, it is respectfully submitted that this application is in condition for allowance. Alternatively, if the Examiner is of the view that the application is not in clear condition for allowance, it is requested that the Examiner telephone the undersigned for purposes of conducting a telephone interview to resolve any outstanding differences. Accordingly, an early notice of allowance is earnestly solicited.

Respectfully submitted,

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Date



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